

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The Examiner objects to the abstract, but has not specifically identified what language the Examiner objects to. Applicant could find no use of the terms “the disclosure concerns...” or “the disclosure defined...” or “the disclosure describes...”, etc. The abstract is in narrative form, is clear and concise, and does not use “means” language. The Examiner is requested to either specifically identify the problematic language or to withdraw the objection..

Claims 1-4 and 7-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Iwasaki (U.S. 4,463,341) in view of Fendt *et al.* (U.S. 6,477,457). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites a “power converter” which “converts an electrical power bus input of a first voltage into a power output at a second voltage for powering the loads”. Claim 13 recites a similar (but further limited) “power converter” at lines 25-29. The cited references do not suggest this element of claims 1 and 13.

The Examiner admits that Iwasaki does not teach the cited element of claim 1 (and claim 13). Instead, the Examiner cites Fendt for teaching the cited element. However, a close reading of Fendt does not support the Examiner’s conclusion. The prior art reference(s) also must teach or suggest *all* of the claim elements and *all* of the claim limitations (MPEP §2143.03). The combination fails for the following two reasons:

First, the converter 9 of Fendt is not described as a voltage converter. Nowhere does Fendt suggest that its converter 9 is for converting a voltage. The term “converter” is used in the electronic arts in a number of ways, and standing alone, the term “converter” does not imply *voltage* converting without some suggestion in the circuit itself, or the accompanying text. The circuit shown in FIG. 2 of Fendt does not suggest that the converter 9 is for voltage conversion. Further, the accompanying text (found at col. 4 line 62 to col. 5, line 5) does not clarify what the converter is converting. Accordingly, Fendt does not teach a power

converter for converting “a first voltage into a power output at a second voltage” as recited in the claims.

Second, claim 1 recites that the power converter has the electrical power bus as an input, while claim 13 recites that the power converter is converting the bus voltage into a second voltage. However, FIG. 2 clearly shows that the converter 9 of Fendt does not connect to the electrical power bus 5. Instead, the converter 9 of Fendt connects to the intermediate storage device 4, the charger 8, the ignition storage device 2, the switch 3, and inputs a control signal s2 from the control 10. Nowhere is it suggested that the converter 9 connects to the bus 5. In fact, Fendt specifically describes that the charger unit 8 *decouples* the bus 5 from the intermediate storage device 4 (and hence the converter 9—see col. 4, lines 60-61), and thus the bus 5 is clearly not input to the converter 9, and further the converter 9 never sees the bus voltage. Thus, Fendt does not teach the cited limitation of claim 1.

Consequently, claims 1 and 13 are patentable over the references for either, or both, of the above reasons, even if the references are combined.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the references (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is also not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

The Examiner has cited no support for any such suggestion in the reference, and the Examiner provides no references supporting any motivation to modify the reference. A conclusory statement of an advantage, such as the one provided by the Examiner in the Office action, is not sufficient to show obviousness.

Merely listing an advantage of the combination is not sufficient, as some rationale for combining the references must be found in the references, or drawn from a convincing line of reasoning based on established scientific principles that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in

the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

Accordingly, because the Examiner has failed to provide the proper motivation to combine the references, the rejection for obviousness is improper, and thus claim 1 is patentable over the references.

Dependent claims 2-12, which depend on claim 1, directly or indirectly, are patentable for all of the same reasons as claim 1, and for the limitations contained therein. Claims 14-18, which depend on claim 13, directly or indirectly, are patentable for all of the same reasons as claim 13 and for the limitations contained therein.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32518 (LD11387).

Respectfully submitted,

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